

Hearing:
September 21, 2005

This Opinion is Not
Citable as Precedent
of the TTAB

Mailed:
December 21, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sharp Kabushiki Kaisha, TA Sharp Corporation

Serial No. 76479027

Robert W. Adams of Nixon & Vanderhye P.C. for Sharp
Kabushiki Kaisha.

Brian J. Pino, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Seeherman, Rogers and Drost, Administrative
Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Sharp Kabushiki Kaisha (applicant) has applied to register WARM & TOASTY, in standard character form, on the Principal Register as a trademark for "microwave ovens for cooking, microwave ovens for cooking with a toaster feature," in Class 11. The application is based on applicant's intention to use the mark in commerce on or in connection with the identified goods and has not been amended to assert use in commerce.

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of the prior registration of the mark TOASTY for "electric toasters" (registration no. 1454113). The cited registration is listed in USPTO records as being owned by Sanyo Fisher (US), and affidavits filed under Section 8 and 15 of the Lanham Act have been accepted and acknowledged, respectively. The mark in the cited registration is registered in standard character form (formerly referred to by the Office as typed form).

When the refusal of registration was made final, applicant filed a notice of appeal. Applicant and the examining attorney have filed briefs, and oral arguments were presented during a hearing before this panel.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); see also, In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential

characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning first to the marks, in comparing them we must consider the similarities or differences in appearance, sound, connotation and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The examining attorney initially contended that because the marks share the common word TOASTY "the respective marks share a highly similar sound, connotation, and appearance" and create the same general impression. Office action of July 1, 2003. In contrast, applicant contended that the involved marks are "quite different when spoken and they convey a different meaning or connotation." Response to July 1, 2003 office action. Applicant also contended that the first part of its mark (i.e., the word WARM) is the dominant portion of its mark and therefore its mark is dissimilar to the mark in the cited registration. Id.

In the final refusal of registration, the examining attorney admitted no disagreement with applicant's contention that the marks are different in pronunciation and appearance, but contended that applicant has merely added the word WARM to the registered mark, and explained

that the addition does not create in applicant's mark a composite with a different commercial impression than that presented by the registered mark. Office action of January 30, 2004. In fact, the examining attorney asserted, applicant's addition of "WARM &" to "TOASTY" emphasizes the latter. *Id.* In essence, the examining attorney views "WARM" in this context as "inherently weak," because applicant's goods include microwave ovens, which are used to warm food (brief, p. 3), and because the term merely emphasizes the meaning of "TOASTY" as "a physical feeling of pleasant warmth" (brief, p. 4).

Neither applicant nor the examining attorney put into the record a dictionary definition of "warm," but the examining attorney, in his brief, cites to a dictionary definition of "toasty" as "pleasantly warm." Brief, p. 5.¹ We take judicial notice of the first of numerous definitions for "warm" in Webster's Third New International Dictionary (1993; p. 2576): "having or manifesting heat esp. to a moderate or pleasurable degree; *usu*: not quite hot." We also take judicial notice of the following complete definition of "toasty" in the same dictionary (p. 2402): "1: having the appearance or taste of toast 2:

¹ Applicant, in its reply brief, does not object to the examining attorney's proffer and, in fact, discusses the definition.

pleasantly or comfortably warmed < the room was snug and
~>."

We agree with the examining attorney that the marks, although they sound and look different, have the same connotation of a moderate or comfortable degree of heat, and create the same general commercial impression. This weighs in favor of a finding of likelihood of confusion. See In re Sarkli, Ltd., 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) ("the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark").

We turn then to a comparison of the goods. Though applicant, after being refused registration, deleted "toasters" from its identification, the identification still includes "microwave ovens for cooking with a toaster feature." To illustrate what a microwave oven "with a toaster feature" is, the examining attorney has put into the record a reprint of a webpage (www.outpost.com) of Fry's Electronics, which offers to consumers a microwave oven with a two-slice toaster on the right side ("No your eye's [sic] are not tricking you, there is a built in toaster on the right side of this microwave oven. Perfect for small kitchens and workplaces..."). Applicant did not

object to this evidence as an inapposite or incorrect illustration of the nature of its identified product. Moreover, in its response to this office action and as part of applicant's effort to convince the examining attorney to accord the cited registration a limited scope of protection, applicant submitted a list of certain third-party registrations, two of which assertedly cover a "microwave oven with a toaster feature."

While a microwave oven with an integral toaster is not directly competitive with a simple toaster, these goods are clearly related. Some prospective purchasers of electric toasters, who have small kitchens, may very well be prospective purchasers of microwave ovens with an integral toaster. In addition, the examining attorney has put into the record third-party registrations showing registration of a single mark for various goods, including both toasters and microwave ovens, i.e., for the goods in the cited registration and the other item listed in applicant's identification of goods. Such registrations, based on use of the registered marks in commerce, are probative on the question of whether applicant's regular or standard microwave ovens (those without the toaster feature) and registrant's electric toasters are related goods for purposes of the likelihood of confusion analysis. See In

re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993) (Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source.). Apart from the registrations, the examining attorney has also put into the record reprints of five web pages showing online retailers that offer both toasters and microwave ovens. Finally, we note that applicant has not argued in either its main brief or in its reply brief that the involved goods are not related, focusing instead on its arguments that the marks are different (a contention with which we disagree), and that the registered mark is descriptive or generic and "incapable of legal protection as a trademark." Brief, p. 4.

As to this latter argument, we find that applicant has engaged in clear, unequivocal and impermissible collateral attacks on the cited registration. See In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997). See also Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc., 1 USPQ2d 1445, 1454 (TTAB 1986) ("Thus, the argument appears to be a mere descriptiveness argument dressed in 'scope of protection' clothing...").

Applicant has made of record reprints of web pages from nine different web sites, chat rooms, or web blogs. All except one arguably use "toasty" in a descriptive fashion. The ninth uses "toasty" in an anthropomorphism ("Ever wished you could check up on your toaster while you were at work, just to say 'hi?' Saddened that ol' toasty doesn't have an e-mail address?").² Offered in support of applicant's collateral attack on the cited registration, this evidence is of little probative value in the context of this appeal. Accordingly, the cited registration has been accorded all the statutory presumptions to which it is entitled.

With respect to the protection to be accorded the cited registration, applicant has attempted to show that the registration is weak and entitled to a limited scope of protection by referencing the asserted issuance of six third-party registrations for marks including the root word "toast." As the examining attorney did not advise applicant that it could not make third-party registrations of record by merely listing the marks, registration numbers and identifications (or relevant part thereof), we overrule

² This one example does not establish, as contended by applicant at p. 4 of its brief, that "the term 'toasty' is a recognized nickname for a toaster." (Emphasis in original.)

the examining attorney's objection to this evidence, set forth for the first time in the examining attorney's brief. Nonetheless, the value of the list of six registrations is very limited. We do not have copies of the registrations. More importantly, not one of the registered marks in the list includes the word TOASTY; rather, they include "toast," "toasting," "toastec" or "toaster." Thus, contrary to applicant's argument, these registrations do not establish that the registered mark is entitled to a limited scope of protection because it is one of many marks incorporating the term "toasty."

In short, we find the marks so similar and the goods so closely related that the registration of applicant's mark is likely to cause confusion. Consumers familiar with registrant's toasters sold under the TOASTY mark, when they encounter applicant's microwave ovens, with or without a toasting feature, sold under the WARM & TOASTY mark, will be likely to assume the goods have a common source or common sponsorship.

Applicant argues that there will be no confusion as to source or sponsorship because it and registrant will each, "in the actual marketplace," use their respective house marks, SHARP and SANYO. Reply Brief, p. 5, n.3. It is well settled, however, that neither applicant's assertion

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that it will use its house mark with the WARM & TOASTY product mark nor registrant's asserted practice of using its house mark with its TOASTY mark can obviate a finding of likelihood of confusion. See Frances Denney v. Elizabeth Arden Sales Corp., 263 F.2d 347, 120 USPQ 480, 481 (CCPA 1959)("In determining the applicant's right to registration, only the mark as set forth in the application may be considered; whether or not the mark is used with an associated house mark is not controlling."); and Blue Cross and Blue Shield Association v. Harvard Community Health Plan Inc., 17 USPQ2d 1075, 1077 (TTAB 1990). See also INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992)(Applicant's argument that registered mark of opposer used with a house mark found not controlling.).

Decision: The refusal of registration under Section 2(d) is affirmed.